



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,060	03/02/2000	Andrew Scott Field	KDO.188020-1	5292

25763 7590 05/29/2003

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/518,060

Applicant(s)

FIELD ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant canceled Claim 17 and amended Claims 1-12. All pending claims, 1-16, were examined in light of the amendment and stand rejected in this final office action.

Response to Arguments

The Applicant's arguments with respect to Claims 1-16 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment. New art was cited that solves the pertinent problem of providing online customers with convenient means to calculate or estimate the price of services or products using online interactive calculators. This examiner contends that the collection of articles designated as "Online Interactive Calculators" offers a preponderance of evidence that would motivate one of ordinary skill to improve existing online print shop services by providing faster quoting services in order to be or remain competitive. Freedman and Seybold Report (Paper #6) state a goal of expediting print job estimating for an online customer and given the technological uplifts taught by Freedman and Seybold Report, it would be prudent business practice for one of ordinary skill in the art of managing an online print services business to assess the value to online customers by providing better and faster cost estimating tools (e.g. instant price estimating vs.

Art Unit: 3625

hours, day, or days), and given the competitive frenzy catalyzed by the potential of Internet commerce it would be further prudent to implement interactive pricing calculators to neutralize the customer's perceived value of similar pricing tools offered by a competitor. As another example disclosing the use of an online interactive calculator, Sevcik et al, patent number 6,330,542 (cited in Paper #6 as pertinent art but not used as a prior art reference) disclose a print service buyer using the calculator to create immediate quotes (see at least abstract; col. 5, line 15-18).

Regarding Freedman in view of Seybold Reports, Freedman discloses customers using an electronic network to conduct online business with a commercial printing services company. Seybold Report discloses use of the Internet as the state of the art in the commercial printing industry. Since the Internet is a global communication network, one of ordinary skill in the art of managing a print service using a network as disclosed in Freedman would view the Internet as a technological uplift to the system and method of Freedman, and therefore would be motivated to at least investigate business impact resulting from a technological migration from a limited network to the global Internet.

Drawings

1. New corrected drawings are required in this application because Figure 1A does not meet margin requirements. Please refer to 37 CFR 1.84 regarding drawing requirements. The corrected drawings are required in reply to the Office

action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 9-13, and 15-16 are rejected under 35 USC 103(a) as being unpatentable over Freedman, Paper #6, patent number 4,839,829, in view of Seybold Report (a collection of articles cited in Paper #6, PTO-892 Items: U and V), further in view of Online Interactive Calculators (a collection of articles cited in PTO-892 Items: U-X) hereafter referred to as "OIC".**

Freedman teaches an automated control system and method for the printing of a work using a variety of conventional and emerging graphic arts processes and techniques. The system interacts with a user or customer, hereafter referred to as a requester, over a computer network for collecting and storing information or parameters regarding the requester's needs (e.g. cost requirements, photos, pictures, graphics, colors used). The information gathered from the requester is correlated with a database of stored information from a specific or various printing facilities, and the requester is instantaneously provided with accurate

Art Unit: 3625

information regarding costs, print facility capacity, scheduling, and with information relating to relevant alternatives which can expedite the ordering process (please see at least abstract; Fig. 1a (12, 20, 24, 36, 44); Fig. 2a; col. 1, line 10 through col. 4, line 2). Freedman teaches the network incorporating expert systems software that reviews the inputs from the requester. Once the central computer is provided with all the previously described information for the printing job, the computer automatically returns cost information, timing, and other pertinent information to the requester's computer. Freedman teaches requester batch loading and entire work and transmitting a work comprising: newsletters, magazines, books, pamphlets, poster, reports, flyers, direct mail items, directories, business cards and "virtually all types of printed matter," and delivering printed material to the requester (see at least col. 8, line 14). Freedman further teaches the requester connecting to the printing service remotely from home, office, or from an "in-house" computer located in the same building or building complex, and the online service collecting requester billing data (see at least col. 8, lines 1-5). Freedman further teaches supplying the service with printing parameter information specifying color printing requirements, and print process that support color printing (see at least col. 2, lines 32-33).

Freedman teaches all the above as noted under the 103(a) rejection and further teaches supplying to the requester a configurator, and returning an automated cost calculation back to the requester, but does not disclose supplying the cost calculator to the requestor. Seybold Report teaches the current state of

the printing industry regarding use of the Internet and further teaches A&a Printers establishing an Internet web site using HTML that allows requesters to submit print jobs online and to estimate job costs before committing to the printing service using online estimating tools to calculate shipping-weight and spine-thickness (see at least Item U, pages 2 and 7; Item V, pages 1-5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman to supply cost calculators as taught by Seybold Report, in order to help requesters conveniently estimate printing costs prior to committing with a printing service provider.

Freedman teaches all the above as noted under the 103(a) rejection and further teaches use of computer networks and telephone lines as a communication medium, but do not specifically disclose a global communication network. Seybold Report teaches all the above as noted under the 103(a) rejection and further teaches use of the Internet to connect requesters with printing services. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman to include the Internet as a global communications network as taught by Seybold Report, in order to market services on a global basis, and thereby increase revenue opportunities for the services site.

Freedman teaches all the above as noted under the 103(a) rejection and further teach printing to encompass any and all processes comprising letter press, intaglio, gravure, lithographic, electrophotographic, flexographic, ink jet,

Art Unit: 3625

thermographic, and offset lithographic (see col. 4, lines 33-35). Freedman, however, does not disclose a digital press. Seybold Report teaches all the above as noted under the 103(a) rejection and further teaches a company offering prepress operations and graphic design agency that uses a variety of modern printing technologies including an Indigo E-Print digital press (see at least Item: U, pages 5 and 6). Therefore it would have been obvious to one of ordinary skill in the art at a time of the invention to modify the system and method of Freedman to include a digital press as taught by Seybold Report, in order to sell services offering the advantages of newer printing technologies.

Freedman and Seybold Report teach all the above as noted under the 103(a) rejection and teach cost estimating and use of a cost calculator but do not disclose online interactive calculators used for iteratively determining cost based on requester-supplied criteria. OIC teaches:

- Interactive web sites that help the requester, through interactive calculators, calculate required retirement savings using criteria comprising amount to be saved, interest rate, and time; a home-price calculator using salary, down payment, interest rate and other criteria to determine the type of house the user can afford; a car-buying cost calculator; a cost calculator for figuring student loan costs; and a salary relocation cost calculator (see at least Item: U, pages 1-2),

- Interactive cost calculator that advises on the cost of borrowing money and allows comparisons between each type of mortgage and their charges within a matter of seconds (see at least Item: V, pages 1-2),
- UPS' home page providing a Quick Cost Calculator to determine expenses (see at least Item: W, page 3), and
- Merrill Lynch's Personal Finance Center that provides clients with an interactive calculator to illustrate the cost of letting credit-charges pile up (see at least Item: X, page 3).

Therefore it would have been obvious to one of ordinary skill in the art to modify the system and method of Freedman and Seybold Report to provide faster cost calculation tools to requesters as taught by OIC, in order to provide competitive online print job estimating turn-around time, and thereby attract requesters to the online service site.

- 2. Claims 7 and 8 are rejected under 35 USC 103(a) as being unpatentable over Freedman, Paper #6, patent number 4,839,829, Seybold Report (a collection of articles cited in Paper #6, PTO-892 Items: U and V), and OIC (a collection of articles cited in PTO-892 Items: U-X), as applied to Claim 1, in further view of Official Notice regarding approval for proofs.**

Freedman, Seybold Report, and OIC teach all the above as noted under the 103(a) rejection and further teach electronic job submission comprising copy and proofs and accessing proofs electronically via URLs (see at least Item U, page

2), but does not disclose obtaining approval from requesters of said proofs. This examiner takes the position that the primary purpose of using proofs is to gain approval from the requester prior to purchasing the finished product, else most if not all the need for the proof is a wasted expenditure. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to obtain requester's approval of the electronically accessible proofs as taught by Official Notice, in order to ascertain the requester's agreement with the proposed finished product.

- 3. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Freedman, Paper #6, patent number 4,839,829, Seybold Report (a collection of articles cited in Paper #6, PTO-892 Items: U and V), and OIC (a collection of articles cited in PTO-892 Items: U-X), as applied to Claim 12, further in view of Printing Impressions (Paper #6, PTO-892 Item: W).**

Freedman, Seybold Report, and OIC teach all the above as noted under the 103(a) rejection but do not disclose RGB format. Printing Impressions teaches desktop publishing Pantone's ColorDrive with web tools application-independent desktop color management system. Printing Impressions teaches color spaces comprising CMYK, RGB, HSL, Apple Color Picker, CIE, and YIQ, and standard printing and publishing applications (please see Paper #6, PTO-892 Item: W, page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman, Seybold

Art Unit: 3625

Report, and OIC to include RGB format as taught by Printing Impressions, in order to produce more complex colors.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Art Unit: 3625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

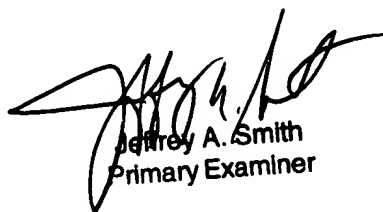
Washington D.C. 20231

or faxed to:

703-305-7687 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
May 21, 2003



Jeffrey A. Smith
Primary Examiner